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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/724,923 | 12/01/2003 | Shenghong A. Dai | U 014915-5 | 3231 |

7590

03/16/2006

Ladas & Parry
26 West 61st Street
New York, NY 10023

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| EXAMINER |
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NILAND, PATRICK DENNIS

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| ART UNIT | PAPER NUMBER |
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1714

DATE MAILED: 03/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/724,923

Applicant(s)

DAI ET AL.

Examiner

Patrick D. Niland

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/05,12/03.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 1714

1. Claims 9-11, 15-16, 32-34, and 38-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. The instant claims 9-11 and 32-34 recite a molecular weight regarding a polymeric compound without stating whether number average, weight average, viscosity average, z average, etc. is intended. The instant specification does not enable a polydispersity of exactly one and a polydispersity of exactly one is believed to be unachievable. It is therefore unclear what type of polymer molecular weight is intended. The significance of this is well known and taught in general polymer texts.

B. The instant claims 15-16 and 38-39 recite tradenames. The use of tradenames in the claims is improper because the manufacturer is under no obligation to continue making these tradenames nor to continue making the same thing under these tradenames. A change in or discontinuance of these tradenames would render the claims meaningless. See MPEP 608.01(v)

[R-2] Trademarks and Names Used in Trade.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 7-25, 30-48, and 52-66 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 5202377 Thorne et al..

Thorne discloses a polyisocyanate mixture falling within the scope of the instant claims at the abstract; column 2, lines 60-68; column 3, lines 1-68, particularly 1-6, 13-14, 15-28, 42-47 which is an aliphatic polyisocyanate because the NCO groups are attached to aliphatic moieties, 47-65, and 66-68; column 4, lines 1-13 where Z is NH falls within the scope of the instant claims and encompasses the instantly claimed EO:PO ratios, 14-24 which encompasses the instantly claimed Jeffamines, 25-32, 42-56; column 5, lines 9-68, particularly 38-58; column 6, lines 1-43; and the remainder of the document.

5. Claims 1-3, 7-25, 30-48, and 52-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5202377 Thorne et al..

Thorne discloses a polyisocyanate mixture falling within the scope of the instant claims at the abstract; column 2, lines 60-68; column 3, lines 1-68, particularly 1-6, 13-14, 15-28, 42-47 which is an aliphatic polyisocyanate because the NCO groups are attached to aliphatic moieties, 47-65, and 66-68; column 4, lines 1-13 where Z is NH falls within the scope of the instant claims and encompasses the instantly claimed EO:PO ratios, 14-24 which encompasses the instantly claimed Jeffamines, 25-32, 42-56; column 5, lines 9-68, particularly 38-58; column 6, lines 1-43; and the remainder of the document.

It would have been at least obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed combinations of ingredients in the compositions of the patentee because they are encompassed by the patentee and would have been expected to give the properties described by the patentee.

Art Unit: 1714

6. Claims 1-11, 15-19, 22-34, 38-42, 45-46, and 49-51 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 5367017 Rosthauser et al..

Rosthauser discloses the instantly claimed compositions at the abstract, at which the excess of polyNCO will give NCO functionality of the instant claims; column 2, lines 28-68; column 3, lines 1-68, particularly 5-15; column 4, lines 1-68; column 5, lines 1-68, particularly 34-56; column 6, lines 1-68, particularly 1-36; column 7, lines 1-68; and the remainder of the document.

7. Claims 1-11, 15-19, 22-34, 38-42, 45-46, and 49-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5367017 Rosthauser et al..

Rosthauser discloses the instantly claimed compositions at the abstract, at which the excess of polyNCO will give NCO functionality of the instant claims; column 2, lines 28-68; column 3, lines 1-68, particularly 5-15; column 4, lines 1-68; column 5, lines 1-68, particularly 34-56; column 6, lines 1-68, particularly 1-36; column 7, lines 1-68; and the remainder of the document.

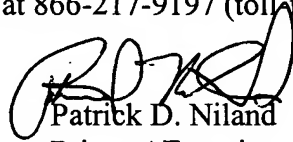
It would have been at least obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed combinations of ingredients in the compositions of the patentee because they are encompassed by the patentee and would have been expected to give the properties described by the patentee.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).


Patrick D. Niland
Primary Examiner
Art Unit 1714